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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,943	06/15/2001	Kiril A. Pandelisev	PHOENIX SCIENTIFIC	5959

7590 06/04/2004  
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EXAMINER  
LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/880,943

Applicant(s)

PANDELISEV, KIRIL A.

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-240 is/are pending in the application.
- 4a) Of the above claim(s) 1-108, 123-127 and 136-240 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 109-122 and 128-135 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/15/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of claims 109-122, 128-148, and 177-191 is acknowledged. The traversal is on the ground(s) that the invention is unitary and is neither independent nor distinct. This is not found persuasive because applicant failed to give reasons as to why a method and apparatus for making silica and a hollow body, rod, tube, or plate have different modes of operation and or different functions such as for the use as a mixer in glass melt furnace. In regards to applicant arguing sub-combination and combination, it's unclear to what said argument is being directed to, since a holding of sub-combination and combination has not been made. In regards to the argument that the restricted species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case (See MPEP 808.01(a)).

In regards to the argument that no serious burden has been established, applicant is directed to MPEP 803 which states "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." Hence, as noted in the restriction requirement groups one and two have separate classification and different field of search thus a prima facie case has been established.

The requirement is still deemed proper and is therefore made FINAL.

Applicant has provisionally elected species Y drawn to figure 5. The election made on 3/23/04 elected the species shown by figure 5 having a plurality of substrates. Elected claims 136-148 and 177-191, require a single substrate in combination with a means for controlling the pressure which does not currently read on figure 5 having a plurality of substrates. In the interest of compact prosecution, claims 136-148 and 177-191, reciting a single substrate with pressure control, not reading on the elected species figure 5 showing a plurality of substrates, are withdrawn from consideration. Hence claims 109-122 and 128-135 are being examined.

#### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(3) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 109-122, 136-148, and 177-191 of this application. The provisional application fails to support first movers and second mover as recited in claims 109-122. Additionally, the provisional application fails to support

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providing a pressure control connected to a chamber and a controlling pressure in the chamber as recited in claims 136-148 and 177-191.

### ***Claim Objections***

Applicant is advised that should claim 137 be found allowable, claim 177 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109-122 and 133 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "the first mover" at line 5 of claim 109 lacks antecedent basis.

The term "first and second movers" at line 2 of claim 110 lacks antecedent basis.

The term "the heater" at line 1 of claim 111 lacks antecedent basis.

The terms "the rotation and translation mechanisms" at line 3, and "the independent rotation and support mechanism" at lines 4-5 of claim 117 lacks antecedent basis.

The term "the preform forming chamber" at lines 2 and 3 of claim 120 lacks antecedent basis.

The term "the chambers" at lines 3 of claim 120 lacks antecedent basis.

The term "the providing of particles" at lines 1 of claim 133 lacks antecedent basis.

### ***Double Patenting***

Claims 128-135 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 09/881,091. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed limitations recited in claim 128 of "providing a chamber, providing a plurality of substrates within the chamber, relatively rotating the plurality of substrates with respect to each other in the chamber, heating the chamber and the substrates, directing silica particles inward in the chamber toward the substrates, fusing silica particles on the substrates, and sticking particles to particles held on the substrates and forming porous silica preforms on the substrates, and relatively moving the substrates and preforms in the chamber" are paraphrased in claim 23 of Application No. 09/881,091.

In regards to claim 134, the manufactured porous preform is conventionally vitrified and densified as shown in claim 24 of Application No. 09/881,091 in order to produce the fiber optics.

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In regards to claim 135, the forming of doped or undoped cores and cladding as shown in claim 23 of Application No. 09/881,091, are conventional steps taken in order to obtain the desired optical fiber.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art is being cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
STEVEN R. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
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